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IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 857

CHARLES J. HIRSCH, *Petitioner*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

MILES D. PILLARS
821 National Press Building
Washington 4, D. C.
Attorney for Petitioner

Of Counsel:
EDWARD A. RUESTOW
59-25 Little Neck Parkway
Little Neck 62, New York

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

TABLE OF CONTENTS

	Page
Citations to Opinion Below	1
Jurisdiction	2
Questions Presented	2
Statute Involved	3
Statement	3
Reasons for Granting the Writ	12
1. The Arbitrary Treatment of Hirsch is an Issue of Imperative Public Importance	12
2. Arbitrary Exercise of Power by an Administrative Agency is an Issue of Imperative Public Importance	12
3. An Interpretation of 35 USC 112 is of Imperative Public Importance	18
4. In Conflict with Decisions of this Court, 35 USC 112 Has Been Construed to Add Burdens Not Authorized by Congress	18
Conclusion	24
Appendix A	
Opinion, Court of Customs and Patent Appeals	1a
Appendix B	
28 USC 1256	12a

TABLE OF AUTHORITIES

Cases

Caminetti v. United States, 242 US 470	18
General Radio Company v. Watson, 188 F. Supp. 879; 125 USPQ 268, 274; DC, DC 1960	14
In Re Chilowsky, 229 F(2) 457; 43 CCPA 775; 108 USPQ 321	21, 22

Page

Loom Company v. Higgins (1881), 105 US 580, pp. 585, 586 21
Reiner v. I. Leon Co., Inc., 2 Cir. 1960; 285 F(2) 501; 128 USPQ 25, 27 23
Yates v. United States, 354 US 298 19

STATUTES

28 USC 1256 ..... 2, Appendix B
35 USC 112 ..... 2, 3, 13, 18, 20, 21, 23
35 USC 141 3

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Charles J. Hirsch prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above-entitled case on October 25, 1961. The decision upon which said judgment is based was given in an opinion dated October 25, 1961. A petition for rehearing was denied on January 12, 1962.

CITATIONS TO OPINION BELOW

The opinion (Item IX)* of the Court of Customs and Patent Appeals was reported in 295 F(2) 251;

* Throughout this petition references to Roman numeral "Items" are to Items I to XVII in the Certified Record of the United States Court of Customs and Patent Appeals accompanying this petition.

49 CCPA (Patents) 745, 131 USPQ 198. A copy of the opinion is printed herein as Appendix A.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered October 25, 1961 (Item X). A Petition for Rehearing (Item XI) of the decision in an opinion (Item IX) dated October 25, 1961 was denied January 12, 1962 (Item XVI). The jurisdiction of this Court is invoked under 28 USC Section 1256 (Appendix B).

QUESTIONS PRESENTED

A. What is the meaning of 35 USC 112 which is of imperative public importance to the scientific and industrial community in its deep concern with the validity of patents for inventions? What did Congress wish it to do in describing inventions? What did Congress wish the Patent Office not to do?

A-1. Contrary to decisions of this Court, may the plain command of 35 USC 112 that a patent specification describe an invention so as to "enable any person skilled in the art to which it pertains * * * to make and use the same," be so enlarged by the Court of Customs and Patent Appeals and the Patent Office as to force upon an inventor the added burden that a challenged capability of a described, well known engineering tool must be established by

1. being found in a printed publication;
2. being of known conventional nature;
3. being spelled out as to component values;
4. being so disclosed that those skilled in the art need not have to design circuitry.

A-2. Where an inventor who is an acknowledged expert in his art, unchallenged as to credibility, has sworn to the ability of those skilled in his art to construct a common engineering tool, from examples which he identified in the professional literature, may he be deprived of his statutory right to a patent by an arbitrary assertion of a Patent Office examiner of unknown expert status that he knows of no such tool, particularly where the examiner does not even explain his doubt, nor why the inventor's assertion is supposedly erroneous, nor attack the inventor's credibility.

STATUTE INVOLVED

The statutory provision involved is the first paragraph of 35 USC 112, which directs what a patent specification shall contain, and reads as follows:

> "The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention".

STATEMENT

Following an appeal from the Board of Appeals of the United States Patent Office in accordance with 35 USC 141, a five judge Court of Customs and Patent Appeals in a majority opinion of three judges, accompanied by dissents of two judges (Item IX), failed to answer the first (A) of the foregoing questions and answered the second (A-1) and third (A-2) in the affirmative. Petition for Rehearing was denied (Item

XVI), as well as Petitioner's Motion to Correct for Diminution of the Record (ItemXII) to add irrelevant portions of the Patent Office proceedings to remove a cloud created by prejudicial insinuations that relevant parts of the record were missing—portions which it was the duty of the Patent Office to produce instead of raising the cloud. (On this subject, see also page 5 of Item XI, Items XIII, XIV and XV).

On July 28, 1954, petitioner filed in the United States Patent Office his application Serial No. 446,301, for a patent on his invention (TRANSCRIPT OF RECORD, Item I, pages 3 to 15).

The invention relates to a color television system and, in particular, to a combination of well known engineering tools for the purpose of overcoming a special problem in the tool (picture tube) upon which the picture is actually seen. To go into the nature of color television systems in general or into Petitioner's particular system in any further detail would only confuse the issue since the issue is confined to a very specific point, namely, the sufficiency of disclosure of the element 25 (TRANSCRIPT OF RECORD, Item I, Pages 7 and 15) which is designated a "Sampling Sawtooth Signal Generator", a common engineering tool.

FOR THE FIRST TIME in a "FINAL" rejection*, dated June 6, 1957 (Item I, pages 17, 18) the Examiner raised the objection that the generator 25 was not sufficiently described in respect to its required capability of functioning at a frequency of 2 megacycles.

* In the Patent Office "Final" Rejection informs the applicant inventor that the Examiner has made his decision and that the inventor's remedy is by appeal to the Board of Appeals. Opportunity for further argument with the Examiner is extremely limited.

Prior to that the Examiner asserted only grounds of rejection which were later withdrawn; those parts of the Patent Office proceedings were omitted as irrelevant in subsequent proceedings. With regard to the Examiner's thus belated ground of rejection concerning the capability of generator 25 to function at a 2 megacycle frequency, he said in the "FINAL" rejection:

> "The specification is further deficient in the disclosure of the structure of the generator. The use of rectangles indicates that any apparatus of the type named in the rectangle may be inserted therein without modification. Applicant's disclosure however requires that the sawtooth oscillator operate at two megacycles. Applicant has not indicated what oscillator circuit may be used. All sawtooth oscillators are not operable at this frequency. (Item I, page 17).
>
> "The disclosure does not therefore comply with 35 U.S.C. 112 and is an invitation to experiment. See In re Beach 68 U.S.P.Q. 196." (Item I, page 18).

This is all he said.

After requesting reconsideration (Item I, page 18), Hirsch then submitted an affidavit November 5, 1957, (Item I, page 27) stating as follows:

> "I am an electrical engineer of some thirty years' continuous experience in the field of radio and television. This experience has comprised continuous activity in the design and manufacture of numerous types of electronic equipment employing saw-tooth oscillators, for example, television and radar equipment. Saw-tooth oscillators have been conventional elements of such equipment for two decades.

"For at least the last fifteen years it has been well within the competence and knowledge of the average electronics engineer working within the fields of television and radar to design saw-tooth oscillators operable at the frequency indicated in my above-identified application. For example the constructions indicated in my attorney's REMARKS on October 22, 1957, with reference to the Article in the Proceedings of the Radio Club of America, Volume 26, No. 1, 1949, and in Radio Engineering by Terman, 1947, may be utilized by such an engineer for that purpose and he would have no difficulty making such constructions operate at the frequencies I have indicated in my application."

The Examiner did not comment on the affidavit at this stage of the proceedings.

Hirsch then filed his appeal to the Patent Office Board of Appeals, having no other remedy in view of the final nature of the Examiner's action.

In his "ANSWER" to the Board of Appeals (answering Hirsch's brief to the Board of Appeals) the Examiner defended his position by stating (Item I, pages 28 and 29) that he could not find such a generator in the literature available in his office and dismissed the Hirsch affidavit on the ground that it was "a statement of opinion", intimating that Hirsch should show that such a generator had actually been built.

The Board of Appeals affirmed the Examiner indicating that it was Hirsch's duty to show that the challenged 2 megacycle capability of the generator was "conventional in the prior art" (Item I, page 31).

This is essentially all that the Patent Office said on the issue involved. It produced no evidence indicating

why such capability was not within the skill of the art, not even its own reasons for doubting it. Neither did it explain why any of Hirsch's assertions were supposedly incorrect. Nor did it attack Hirsch's credibility. Both the Examiner and the Board merely indicated that they were not convinced.

The fact that the issue did not arise until the hurried final rejection and belated criticism of the affidavit made it impossible for Hirsch to submit further evidence since the case was then in the appeal stage. Neither could he amend his application without losing the benefit of his priority rights based on the filed date of his application. But even if he had been permitted to submit further evidence or amend his application, all this placed upon Hirsch the burden of searching endless technical literature to find a numerical statement which no engineer would think important enough to put in print unless he was particularly concerned with frequency. The fact that the Examiner could not find it is evidence of its unimportance.

As the application states, (Item I, page 7) sawtooth generators are conventional. In fact, the sawtooth generator has been a well known tool in television for many, many years, as Hirsch stated in his affidavit.

Neither the Examiner nor the Patent Office Board of Appeals challenged the fact that sawtooth generators are well known; they tacitly admitted it, as indeed they must. The Court of Customs and Patent Appeals also conceded it (Item IX, page 5). Rather, the rejection was based on the narrow point that the Examiner did not believe sawtooth generators are available which would be capable of operating at 2 megacycles (Item I, pages 17, 28, 29). Both the Examiner and

the Board of Appeals indicated at numerous points in the record that it is this 2 megacycles capability which governed their thinking (Item I, page 31). For example, the Examiner's Answer, as indicated above, intimates that his basis of rejection is the mere fact that he could not find in his file a reference actually specifying numerically a frequency as high as 2 megacycles (Item I, page 28).

The Court of Customs and Patent Appeals in affirming indicated that it was following the arbitrary standards of the Patent Office which required that the applicant find the challenged 2 megacycle capability in a printed publication, or show that it is conventional, or alternatively, that applicant specify the component values of his generator which would bring about the required capability so as to relieve those who wished to use the invention of any burden of designing the generator.

This conclusion as to the Court's view is to be drawn from the following remarks and quotations made with apparent or express approval:

> "It will be observed that there is lacking here, as it is lacking throughout this case, any assertion *that the publications* disclose a saw-tooth generator operable at or above 2 mc. (Item IX, Opinion, page 4—emphasis ours).
>
> "A search was made in the *literature* available in Division 16 (now in Div. 41) and in Class 250, subclass 36 for a generator operable in this frequency range. The highest frequency found mentioned for such a generator was *200 kilocycles.* (Item IX, Opinion—page 5—quoting Examiner—first emphasis ours).
>
> "Where a device is presented in an application essentially only by means of a labeled rectangle,

with no other description or illustration of specific circuitry, *it must be one of known conventional nature* in the prior art in order that such presentation be regarded as a sufficient disclosure. Ex Parte *Sziklai*, 110 USPQ 325 [Bd.] (Item IX, Opinion, page 6, quoting the Board of Appeals—first emphasis ours).

"If he could not cite any references in the *literature* establishing the '*conventional*' construction of his 2 mc. saw-tooth signal generator, as he asserted it to be, he should have been able to describe it to the examiner. (Item IX, Opinion, pages 6, 7—emphasis ours).

"If he was not in a position to take one of the four very simple circuit diagrams cited, showing lower frequency (100 KC) generators, and supply the component values (parameters) which would make it operate at the required frequency of 2 mc. or higher, then he had not completed his invention. (Item IX, Opinion, page 7).

"We agree with the view of the board that the applicant did not meet 'the burden imposed upon him by what seems to us to be a reasonable criticism made by the examiner'. It was the examiner's duty to compel a disclosure which would enable those skilled in the art to practice the invention without having *to design* circuitry not shown to be readily available in the art." (Item IX, Opinion, page 7).

The two dissenting Judges, Martin and Smith, took essentially the view advocated by the petitioner. Judge Martin said:

"It seems to me that, in order to maintain the position that this application does not comply with 35 USC 112, the examiner and the board should also have stated categorically that the information contained in the pages submitted by appel-

lant was not sufficient to teach one skilled in the art *how to make* a 2 megacycle saw-tooth generator. Further, they should have stated why that is true. It may be that a saw-tooth generator operable at 2 megacycles differs in kind from one operable at 100 or 200 kilocycles, but that fact has not been stated in the record and I do not feel moved to assume that it is or is not true.

"Indeed, the examiner's final rejection and answer and the board's opinion do not convince me that one skilled in the art could not construct the required saw-tooth generator with the knowledge of the reference pages and affidavit submitted by appellant." (Item IX, page 2 of Judge Martin's opinion).

Judge Smith said:

"It seems to me that where the issue here is essentially one of the correctness of technical assertions made, the affidavit of Hirsch as to what one skilled in the television art would know from the disclosure is entitled to greater credence than has been assigned to it in the majority opinion. The affidavit verifies that the disclosure teaches enough so that one skilled in the television art could make and use the invention. An application addressed to 'any person skilled in the art' should be tested by what it discloses to such a person, the best evidence of which, on the record before us, is the affidavit of applicant." (Item IX, page 2 of Judge Smith's opinion).

Indeed, Judge Smith took the most unusual step of finding on his own initiative evidence of 1 megacycle generators in the literature (footnote 1, Item IX, page 1 of Judge Smith's opinion). The footnote reads:

"It is noted that while the examiner's search discovered only a saw-tooth generator operable at

200 kilocycles as quoted in the majority opinion, the *Electrical Engineers' Handbook*, 4th ed. (1950), by Pender and McIlwain indicates that a multivibrator type saw-tooth generator might be made to operate up to 1,000,000 cycles (1*MC*). While this does not necessarily indicate that a person skilled in the art could readily construct a 2,000,000 cycle (2*MC*) saw-tooth generator, it suggests caution in the use of the examiner's failure to find a reference above 200,000 cycles as the sole basis upon which to decide what the disclosure in question teaches one skilled in the art."

Lastly—as a prejudicial irregularity—we point to Hirsch's motion in the Court of Customs and Patent Appeals to strike portions of the brief for the Commissioner of Patents as prejudicial (Item IV). The story behind this is that the Commissioner of Patents had insinuated in his brief that essential portions of the Patent Office record were missing. Hirsch demanded either that the offending portions of the brief be stricken or that the Commissioner of Patents produce the supposedly missing portions, Hirsch denying that any relevant portions were missing and asserting that the omitted portions all had to do with pure formalities or objections of the Examiner, having nothing to do with the issue of this case and which were withdrawn by the Examiner and acknowledged as withdrawn by the Board of Appeals. Upon opposition of the Commissioner of Patents (Item V) expressly acknowledging and expressly declining to exercise his right to move to correct diminution of the record, this motion of Hirsch was denied (Item VII). Later, the Court of Customs and Patent Appeals in its opinion also prejudicially insinuated (Item IX, pages 2 and 5) that pertinent portions of the record were missing.

Hirsch thereupon moved (Item XI, page 5, Item XII, Items XIII and XIV) contemporaneously with his Petition for Rehearing that he, himself, be permitted to produce all omitted portions of the Patent Office record to show that they were indeed irrelevant and thereby to remove the prejudicial cloud over his case, even though it was the duty of the Patent Office to produce any omitted portions it thought relevant. Upon opposition of the Commissioner of Patents (Item XV) this motion, too, was denied (Item XVI).

Thus, the situation is that the Commissioner of Patents deliberately created a prejudicial cloud, refused to justify it as was his duty, and fought the efforts of Hirsch to expose it. And the Court of Customs and Patent Appeals perpetuated it in its opinion.

The record is indeed "very abbreviated" (Item IX, page 2). But it is in the sense that it is short, not incomplete. There was no such thing as "appellant's extreme abbreviation of the record" as the Court of Customs and Patent Appeals prejudicially remarked (Item IX, page 5). The Examiner failed to make any more record than that presented here and in the Court of Customs and Patent Appeals.

REASONS FOR GRANTING THE WRIT

1. The Arbitrary Treatment of Hirsch Exemplifies an Issue of Imperative Public Importance.

2. Arbitrary Exercise of Power by an Administrative Agency Is an Issue of Imperative Public Importance.

This case presents an issue of "imperative public importance" to use the language of this Court's Rule 20.

This case presents a situation where the Court of Customs and Patent Appeals "has so far departed

from the accepted and usual course of judicial proceedings, and so far sanctioned such departure by a lower court as to call for an exercise of this Court's power of supervision", to use the language of this Court's Rule 19.

This Court is not being asked solely to reverse a factual determination. It is being asked to examine and reverse the arbitrary abuse of statutory law and the rules of evidence. The facts are here only to show the arbitrary abuse.

It is of imperative public importance that inventors not be arbitrarily deprived of statutory rights by unjustified enlargement of the statutory burden of 35 USC 112 that they disclose to "enable any person skilled in the art * * * to make and use the same"—particularly where the Patent Office has remained totally silent, both as to evidence of its own to support its initial assertion, as to evidence to refute that of Hirsch, and as to evidence impugning Hirsch's credibility.

The Court of Customs and Patent Appeals has "so far departed from the accepted and usual course of judicial proceedings" that it has not only enlarged the statutory burden but it has also ignored the accepted and usual legal practice of judging by the preponderant weight of the evidence. Else why should it have added the additional burdens indicated above that the challenged 2 megacycle capability be found in a publication, or that it be conventional, or that the applicant spell out specific component values? Else why did it completely ignore the Patent Office silence in the matter of evidence? Else why did it pick up and repeat prejudicial insinuations of the Patent Office

that the record was incomplete when it was the duty of the Patent Office to support the insinuations—and certainly not to oppose Hirsch's efforts to expose them?

We submit that cases of this kind should be decided not on the all too abused presumption of Patent Office expertise but on the normal basis of weighing the preponderance of evidence.

The presumption that the Patent Examiner is an expert is an over simplification of very limited accuracy. It loses touch with reality when applied rigidly to the point where he is beyond challenge and his theorizing outweighs assertions of real experts from industry and, particularly, when applied to the point where Examiner is relieved even of the burden of explaining his objection.

As the District Court for The District of Columbia has recently stated in a similar situation:

> "* * * if the Patent Office wishes to discredit expert or lay testimony, the obvious method would be to provide witnesses for that purpose." *General Radio Company* v. *Watson*, 188 F. Supp. 879; 125 USPQ 268, 274; DC, DC 1960.

In short, cases such as this should be based on something more than an Examiner's suspicion that the device will not work.

The latter is apparently the view of dissenting Judges Martin and Smith.

It is, presumably, also the view of Dean James M. Landis who, in writing on "The Administrative Process" in the American Bar Association Journal of February 1961, page 136, criticized this tendency to overrate administrative expertise with the statement:

"'Now, however, a third stage in administrative development seems to be taking place. Its rumblings have been apparent for some time. Some of them have now been brought to light by the work of the House Committee on Legislative Oversight. We are or, at least, we should be examining the truth of certain legends that during these years have been built up about the administrative process. Let me name some of them.

"The first of these is the legend of its possession of expertise—a phrase that I think derives from Harold Laski. It was a nice phrase for the defenders of the administrative process and it had value in demonstrating to the judiciary, generally unfamiliar with the economics of a particular problem, that the solution of that problem, if at all reasonable, should be left to persons who were presumably familiar with it. It probably had merit in the days when Judge Cooley, Commissioners Eastman and Mahaffey sat on the Interstate Commerce Commission. It may have considerable merit today in many specific situations. But on the whole does it exist? It exists obviously in the staffs of many of our agencies. But at the top level, where the responsibility of decision rests, one cannot be too sure. * * *"

So, too, Earl W. Kintner, Chairman of the Federal Trade Commission, who, writing on "Federal Administrative Law in the Decade of the Sixties" in the American Bar Association Journal for March 1961, page 270, picked up the same theme and wrote:

"* * * But on the whole does expertise exist in the agencies? It exists obviously in the staffs of many agencies. But can we truthfully say that those who bear the responsibility of decision truly possess it in the expected measure?

"The obvious and sorrowful answer must be 'no'. One of the reasons compelling this answer

involves the selection of agency members. Another reason, equally important, involves the failure by agency members to justify claims of expertness that are well deserved, for only those who reason and explain and justify can support a claim of expertness.

"Many voices have been raised in opposition to the institutional decision. To these I add my own. The consideration that impersonal mass injustice often produces individual unfairness is reason enough to take such a position, but there is another reason as well—one connected with the health of the administrative process. Only articulate, personal rationalization of decisions can guarantee that personal experience has been brought to bear on an issue. Only reasoned support for a position carefully explained can bring true public confidence in the fairness of the decision. Further, bare findings of fact accompanied by an order do not serve to explain the law and educate those who must comply with the law. If the business community subject to regulation can find no rationalization upon which to base expectations and make plans, then it is no wonder that claims of arbitrariness, of ineptness, and—yes—of outright dishonesty should be heard in the land. The function of the expert is to explain. No one can be an expert who does not explain."

Patent Office Examiners ought not to be beyond challenge. Yet in practice they all too frequently enjoy that advantage. Indeed, it is the Patent Office position that an inventor may not even demand that the Examiner state his qualifications to speak as an expert. That issue was raised contemporaneously with this case in an appeal to the Board of Appeals of the Patent Office, *Ex Parte Donald Richman*, Appeal No. 479-91.

In that appeal there was a prolonged dispute between the Examiner and highly qualified television experts on hypertechnical engineering issues. The applicant requested the Examiner to state his qualifications to speak as an expert but he declined to do so on the ground that this was challenging the Examiner's right to criticize and perform his job. The Examiner's viewpoint was sustained by the Board of Appeals.

One may be excused for asking a question which should answer itself. Where does the real knowledge of our highly scientific arts like television reside—in the men who sweat out its problems in our laboratories and on our factory floors—or in the paper files of the Patent Office? It is just not possible for an examiner, who is, of necessity, a follower of the art and whose function is more that of a quasi judge or lawyer than an engineer, to keep informed as to the intimate knowledge of engineers and scientists in that advanced twilight zone between the "known" and the "new".

This Hirsch case is before this Court as an example of the all too common abuse of administrative power which works extensive injustice in industry at its lowest working levels—at the level of the little yet essential problems which breathe vitality into any industry. In this area, the unreasoned fiat of a lowest level Hornbook learned administrative agent on highly specialized minor technological questions which, in fact, are only within the knowledge of practical industrial specialists on the factory floor, burgeons into a high level legal dispute and does much damage to industry. The very working level nature and frequency of occurrence of these situations make it difficult to combat the arbitrary actions. Economic con-

siderations often force abandonment of the contest and statutory rights since, obviously, all such controversies can not economically be contested as high as this Court or indeed as high as the Patent Office Board of Appeals. It is of imperative public importance to the health of industry that this situation be corrected.

3. An Interpretation of 35 USC 112 Is of Imperative Public Importance.

4. In Conflict With Decisions of This Court, 35 USC 112 Has Been Construed to Add Burdens Not Authorized by Congress.

The meaning of 35 USC 112 is of great public importance. To the scientists, industrialists and ordinary inventors who use it as a medium "to promote the progress of science and useful arts" in accordance with Article I, Section 8 of the Constitution, it is a vital thing. They must know what Congress meant them to do and what Congress meant the Patent Office not to do.

This Court has stated clearly that statutes may not be enlarged beyond their plain meaning. In *Caminetti v. United States*, 242 US 470, this Court said:

> "It is elementary that the meaning of a statute must, in the first instance, be sought in the language in which the act is framed, and if that is plain, and if the law is within the constitutional authority of the law making body which passed it, the sole function of the courts is to enforce it according to its terms. * * *
>
> * * * * * * * * *
>
> "Statutory words are uniformly presumed, unless the contrary appears, to be used in their ordinary and usual sense, and with the meaning commonly attributed to them. * * *" (pages 485 and 486).

The defendant in *Caminetti* contended that although the act in question was clear, it should be interpreted to add the qualification "for hire," since that was the intent expressed in the report which introduced the Act to Congress for passage. To this, this Court answered:

> "* * * Still, the name given to an act by way of designation or description, or the report which accompanies it, cannot change the plain import of its words. If the words are plain, they give meaning to the act, and it is neither the duty nor the privilege of the the courts to enter speculative fields in search of a different meaning.
>
> "Reports to Congress accompanying the introduction of proposed laws may aid the courts in reaching the true meaning of the legislature in cases of doubtful interpretation * * *. But, as we have already said, and it has so often been affirmed as to become a recognized rule, when words are free from doubt they must be taken as the final expression of legislative intent and are not to be added to or subtracted from by considerations drawn from titles or designating names or reports accompanying their introduction, *or from any extraneous source*. In other words, the language being plain, and not leading to absurd or wholly impractical consequences, it is the sole evidence of the ultimate legislative intent." (page 490) (Emphasis ours).

In *Yates v. United States*, 354 US 298, 1 L. Ed. 2d 1356, 77 S. Ct. 1064, this Court said:

> "* * * The intention of the legislature is to be collected from the words they employ. Where there is no ambiguity in the words, there is no room for construction. The case must be a strong one indeed, which would justify a Court in depart-

ing from the plain meaning of words, especially in a penal act, in search of an intention which the words themselves did not suggest. *To determine that a case is within the intention of a statute, its language must authorize us to say so* * * *." (354 US at 305) (Emphasis ours)

* * * * * * * * *

"* * * We too think this statute should be read 'according to the natural and obvious import of the language, *without resorting to subtle and forced construction for the purpose of either limiting or extending its operation.*' *United States* v. *Temple*, 105 US 97, 99, 26 L. Ed. 967, 968." (354 US at 311). (Emphasis ours).

Returning, now, to the Statute 35 USC 112, its standard is clear however broad. It merely requires a showing that the challenged 2 megacycle capability is something which one skilled in the art would be able to think out for himself with the knowledge in his mind as the result of the normal experience of his art. Nothing is said about whether those skilled in the art should be able to find a particular fact in a printed publication, or that it be conventionally available to them, or that the inventor give precise specifications of component values, or that he relieve those skilled in the art of any burden of designing tools. If, indeed, the apparent requirements of the Court of Customs and Patent Appeals and the Patent Office in these respects are correct, there would be no need for Congress to have laid down the "skilled in the art" test of 35 USC 112.

This Court has spoken before on the subject:

"* * * Webster's patent must have been perfectly intelligible to them. When an astronomer reports that a comet is to be seen with the tele-

> scope in the constellation of Auriga, in so many degrees of declination, and so many hours and minutes of right ascension, it is all Greek to the unskilled in science; but other astronomers will instantly direct their telepscopes to the very point in the heavens where the stranger has made his entrance into our system. They understand the language of their brother scientist. If a mechanical engineer invents an improvement on any of the appendages of a steam engine, such as the valve-gear, the condenser, the steam-chest, the walking-beam, the parallel motion, or what not, he is not obliged, in order to make himself understood, to describe the engine nor the particular appendage to which the improvement refers, nor its mode of connection with the principal machine. These are already familiar to others skilled in that kind of machinery. He may begin at the point where his invention begins, and describe what he has made that is new, and what it replaces of the old. That which is common and well known is as if it were written out in the patent and delineated in the drawings." *Loom Company* v. *Higgins* (1881), 105 U.S. 580, pp. 585, 586.

Thus the Court of Customs and Patent Appeals and the Patent Office appear to reject the thought that the references which Hirsch supplied to show conventional sawtooth generators need only show enough to permit one skilled in the art to design a 2 megacycle generator. If so, both were reading more into 35 USC 112 than it says. More, indeed, than the Court of Customs and Patent Appeals required in *In Re Chilowsky*, 229 F(2) 457, 43 CCPA 775, 108 USPQ 321, in which that Court was presented with the same problem as in this case and said:

> "It is true that many of the procedures and material suggested by appellant's application are

identified in general terms, and that exact proportions and amounts are left for determination by those skilled in the art. This would not be a fatal defect if it appeared that those skilled in the art possessed the necessary knowledge to make the required determination. *On that point, very little actual information has been provided either by the appellant or the Patent Office tribunals; the appellant merely asserting that certain knowledge was available in the art, without pointing out where it could be found, while the examiner and the board relied upon general statements that commercial reactors had not been built at the time appellant's application was filed.* The mere fact that something has not previously been done clearly is not, in itself, a sufficient basis for rejecting all applications purporting to disclose how to do it.

* * * * * * * * * *

"Thus, in the usual case where the mode of operation alleged can be readily understood and conforms to the known laws of physics and chemistry, operativeness is not questioned, and no further evidence is required. * * *

* * * * * * * * * *

"The present case does not appear to be of either of the two types last mentioned. On the contrary, it was stated by the Board that 'the basic laws governing atomic fission are known,' and it should, therefore, be possible to test the application disclosure by those laws. *Under such circumstances, we do not consider that a broad allegation that the application disclosure is speculative*, coupled with a recitation of various difficulties which might be encountered in attempting to put it into practice, and a further assertion that there might be still other difficulties which could not be foreseen, constitutes a sufficiently definite statement of a basis for rejection. * * *" (108 USPQ 325) (Emphasis ours)

Lastly, we think Judge Learned Hand's remark in *Reiner* v. *I. Leon Co., Inc.*, 2 Cir. 1950, 285 F(2) 501, 128 USPQ 25, 27, is very apropos of the problem here. He said:

> "* * * To judge on our own this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who were familiar with it * * *."

We think Hirsch was far more familiar with the minutiae of sawtooth generators than the Patent Office.

To sum up—35 USC 112 does not place upon Hirsch any of the burdens imposed by the Court of Customs and Patent Appeals and the Patent Office, indicated by the QUESTIONS PRESENTED above.

> "To determine that a case is within the intention of a statute, its language must authorize us to say so." (*Yates* v. *United States*, above).

Neither the Court of Customs and Patent Appeals nor the Patent Office can find in the language of 35 USC 112 a Congressional intention authorizing the arbitrary standards imposed upon Hirsch.

No law requires Hirsch to show that others had made and operated sawtooth generators at a frequency of 2 megacycles in order to make him eligible to be granted a patent. And, lastly, it was the burden of the Patent Office to produce any portions of the record it deemed missing and relevant to its position; the Court of Customs and Patent Appeals was prejudicial to Hirsch in insinuating in its opinion that relevant portions were missing.

We think, therefore, that Hirsch has been the victim of arbitrary action which this Court should correct.

CONCLUSION

For the foregoing reasons, this petition for a Writ of Certiorari to the Court of Customs and Patent Appeals should be granted.

Respectfully submitted,

MILES D. PILLARS
Attorney for Petitioner

Of Counsel:

EDWARD A. RUESTOW
59-25 Little Neck Parkway
Little Neck 62, New York

APPENDIX A

Date of Decision Oct. 25, 1961

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1961
Patent Appeal No. 6695
Serial No. 446,301

IN THE MATTER OF THE APPLICATION
OF
CHARLES J. HIRSCH

RICH, Judge.

This appeal from the affirmance of the rejection of application Ser. No. 446,301, filed July 28, 1954, for "Color Image-Reproducing Apparatus," raises a single question as to the sufficiency of disclosure under 35 U.S.C. 112.

The drawing of the application is a single sheet showing a color TV receiver in the form of a block diagram consisting, except for symbols representing the antenna, three diodes, and three resistors, of 18 "blocks" or rectangles lettered to indicate various circuits making up the receiver. The connections between these blocks are shown and their connections to antenna, ground, and the like.

The sole question in the case arises with respect to the block which is lettered "SAMPLING-SAWTOOTH-SIGNAL GENERATOR." It bears the reference character "25." The specification refers to it as "a sampling saw-tooth signal generator 25 *of conventional construction* for developing across resistors 26, 27, 28 signals representative of the time intervals during which the magnitudes of positive saw-tooth sampling signals are less than the output signals of the signal combiner." [Emphasis ours.] The specification also states: "The saw-tooth signal generator

25 preferably has an operating frequency higher than an essential minimum of twice the highest frequency color signal component to be translated, for example, *higher than 2 megacycles.*" [Emphasis ours.]

The sole issue is the adequacy of this disclosure of the saw-tooth generator 25. What raises the question of adequacy is the frequency at which the specification says it is to operate, higher than 2 mc.

The record is very abbreviated. It appears to have been limited to parts bearing on this issue and contains only part of the final rejection, a request for reconsideration (in part) with which were filed pages from certain publications and the applicant's affidavit, followed immediately by the appeal to the board, the examiner's answer (in part), and the board opinion (in part). The omissions might have shed some light on how the prosecution actually progressed and we may have an unrealistic picture of it. But from what we have it is clear that the examiner's final rejection held the specification "deficient in the disclosure of the generator" and therefore not in compliance with section 112, because the disclosure "requires that the saw-tooth oscillator operate at two megacycles," the examiner stating "Applicant has not indicated what oscillator circuit may be used."

Following final rejection, applicant submitted to the examiner "Proceedings of The Radio Club of America, Inc.," Vol. 26, No. 1 (1949) referring to pages 6 and 7, Figs. 1, 2, and 3, and page 602 of a text, "Radio Engineering" by Terman (1947). The record contains only Terman page 602 and the title page and pages 6 and 7 of the Radio Club publication.[1] From the Radio Club publication we have

[1] The board opinion shows that the examnier had photostats of pages 1-13 and 3 pages of advertisements from this publication. All that is in the record here are two pages containing 4 diagrams, 3 of which are relied on. From Terman's text the examiner appears to have had only the one page in our record.

three circuit diagrams on which none of the values for the circuit components are given and no description. The text page contains a brief description (referring to some figures not in the record) and three figures (a) of a "Saw-tooth-wave Generator" circuit containing one triod, two batteries, two capacitors, two resistors and the designation "pulse input," no component values being given, and (b) two oscillograms of "Grid voltage" and "Plate voltage." The description in the record concludes, "This arrangement is capable of generating saw-tooth wavys at frequencies much higher than gas tubes can be operated and likewise gives a positive control of the frequency of the saw-tooth wave."

In submitting this material, applicant's attorney referred to the Radio Club publication as disclosing a 100 kilocycle saw-tooth wave generator, which is one-twentieth the frequency of what the specification calls for as a minimum.

We have been unable to find anything in the record or briefs which so much as suggests at what frequencies the "Radio Engineering" generator is capable of operating.

Relying on these disclosures, the applicant, Hirsch, filed an affidavit in which he qualified himself as an expert in the relevant art by virtue of 30 years experience, which we need not question. He then said—and this is all he said which is relevant:

> For at least the last fifteen years it has been well within the competence and knowledge of the average electronics engineer working within the fields of television and radar *to design* saw-tooth oscillators operable at the frequency indicated in my above-entitled application. For example the constructions indicated in my attorney's Remarks on October 22, 1957, with reference to the article in the Proceedings of the Radio Club of America, Volume 26, No. 1, 1949, and in Radio Engineering by Terman, 1947, may *be utilized* by such an engineer *for that purpose* and he would have no

> difficulty making such constructions work at the frequencies I have indicated in my application. [Emphasis ours.]

It will be observed that there is lacking here, as it is lacking throughout this case, any assertion that the publications disclose a saw-tooth wave generator operable at or above 2 mc. The Hirsch affidavit also said "Saw-tooth oscillators have been conventional elements of such [TV and radar] equipment for two decades." That is of no importance here, however, because it was *not* the examiner's objection that saw-tooth oscillators were not known but only that such oscillators or generators *operable at 2 mc.*, in such equipment as applicant's, were not known. In his Answer on the appeal the examiner said:

> The specification states * * * that the frequency of the sawtooth generator has a frequency greater than two megacycles.
>
> A search was made in the literature available in Division 16 (now in Div. 41) and in Class 250, subclass 36 for a generator operable in this frequency range. The highest frequency found mentioned for such a generator was *200 kilocycles.*
>
> Accordingly, the claims were *again* rejected on the ground of incomplete disclosure and made final. [Last emphasis ours.]

It would be reasonable to suppose from the last paragraph that the examiner gave applicant at least two rejections on this ground. What he told applicant except in a portion of the final rejection we have no way of knowing because of appellant's extreme abbreviation of the record, but from what we have been permitted to see we are of the opinion that the examiner made his reasons for the rejection sufficiently clear to comply with 35 U.S.C. 132. In "stating the reasons for such rejection" he said, inter alia,

"All sawtooth oscillators are not operable at this frequency." He also cited the decision of this court in *In re Bedich*, 33 CCPA 815, 152 F. 2d 981, 68 USPQ 196, which should have made it reasonably clear that the basis of the rejection was that from the disclosure one skilled in the art would not be able to practice the invention.

In affirming, the board said:

> Where a device is presented in an application essentially only by means of a labeled rectangle, with no other description or illustration of specific circuitry, it must be one of known conventional nature in the prior art in order that such presentation be regarded as a sufficient disclosure. *Ex parte Sziklai*, 110 USPQ 325. [Bd.]
>
> * * *
>
> Merely to say that such apparatus as in the periodical items could be modified to produce such frequency of operation, without definite and positive establishment that in the light of the circuit parameters involved this operation could be obtained, would seem to us to merely beg the question and fall far short of the adequacy of disclosure necessary to enable one skilled in the art to practice the invention at issue.

We agree with this position. When the application was filed it is to be presumed that the inventor had completed the invention disclosed therein, in the sense, at least, of having a "*complete idea* of means," to use the expression of Robinson on Patents. He would have, then, a complete idea of the specific circuitry to be included in his receiver at the position indicated by his labeled rectangle 25. If he could not cite any reference in the literature establishing the "conventional" construction of his 2 mc. saw-tooth signal generator, as he asserted it to be, he should have been able to describe it to the examiner. If he was not in a position to take one of the four very simple circuit diagrams cited, showing lower frequency (100 Kc) generators,

and supply the component values (parameters) which would make it operate at the required frequency of 2 mc. or higher, then he had not completed his invention.

We agree with the view of the board that the applicant did not meet "the burden imposed upon him by what seems to us to be a reasonable criticism made by the examiner." It was the examiner's duty to compel a disclosure which would enable those skilled in the art to practice the invention without having *to design* circuitry not shown to be readily available in the art.

As we said in *In re Nelson et al.*, 47 CCPA 1031, 1048, 280 F. 2d 172, 126 USPQ 242,

> There always exists, on the part of some people, a selfish desire to obtain patent protection without making a full disclosure, which the law, in the public interest, must guard against. Hence section 112 calls for description in "full, clear concise, and exact terms" and the "best mode" requirement does not permit an inventor to disclose only what he knows to be his second-best embodiment, retaining the best for himself.

That policy would not be furthered by reversing the rejection in this case, wherein applicant has told neither what the construction of his generator is nor where a description of it may be found in the prior art. The question raised by the examiner seems to have uncovered a fatal defect in the application. It may be that the generator in question was well known at the time the application was filed, but if it was, we have no way of knowing it from the record before us.

The decision of the board is *affirmed*.

AFFIRMED

Date of Decision Oct. 25, 1961

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1961
Patent Appeal No. 6695
Serial No. 446,301

IN THE MATTER OF THE APPLICATION
OF
CHARLES J. HIRSCH

MARTIN, Judge, dissenting.

I believe that this case should be remanded to the board for further consideration since I am not convinced that the disclosure at bar would not "enable any person skilled in the art * * * to make and use * * *" the disclosed invention.[1]

In response to a criticism by the examiner that the disclosure did not comply with 35 U.S.C. 112, appellant submitted certain pages from "Proceedings of the Radio Club of America, Inc." and "Radio Engineering" by Terman, and stated in the form of an affidavit in effect that one skilled in the art would know how to use the information contained in these pages to construct a 2-megacycle saw-tooth generator. Subsequent criticism by the examiner and the board was limited to statements that a saw-tooth generator operable at 2 megacycles is not *affirmatively disclosed* in these reference pages and affidavit and there is no evidence that anyone has ever built such a generator.

It seems to be that, in order to maintain the position that this application does not comply with 35 U.S.C. 112, the examiner and the board should also have stated categorically that the information contained in the pages submitted by appellant was not sufficient to teach one skilled

[1] 35 U.S.C. 112.

in the art *how to make* a 2 megacycle saw-tooth generator. Further, they should have stated why that is true. It may be that a saw-tooth generator operable at 2 megacycle differs in kind from one operable at 100 or 200 kilocycles, but that fact has not been stated in the record and I do not feel moved to assume that it is or is not true.

Indeed, the examiner's final rejection and answer and the board's opinion do not convince me that one skilled in the art could not construct the required saw-tooth generator with the knowledge of the reference pages and affidavit submitted by appellant.

Date of Decision Oct. 25, 1961

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

October Term 1961
Patent Appeal No. 6695
Serial No. 446,301

IN THE MATTER OF THE APPLICATION
OF
CHARLES J. HIRSCH

SMITH, Judge, dissenting.

The statutory test as to the sufficiency of a disclosure under 35 U.S.C. 112; requires a factual consideration of the record to determine whether the disclosure is in fact such a disclosure as "to enable any person skilled in the art * * * to make and use" the disclosed invention.

The first step in applying this test requires us to determine what the disclosure communicates to a person skilled in the art to which the disclosure pertains. The examiner, the Board of Appeals and the majority opinion find the disclosure inadequate because the art of record does

not disclose a saw-tooth generator of conventional construction operable at a frequency higher than 2 megacycles.[1]

I do not think this is an adequate basis upon which to determine what is communicated by the disclosure in issue to one skilled in the television art.

It seems to me that where the issue here is essentially one of the correctness of technical assertions made, the affidavit of Hirsch as to what one skilled in the television art would know from the disclosure is entitled to greater credence than has been assigned to it in the majority opinion. The affidavit verifies that the disclosure teaches enough so that one skilled in the television art could make and use the invention. An application addressed to "any person skilled in the art" should be tested by what it discloses to such a person, the best evidence of which, on the record before us, is the affidavit of applicant.

Under these circumstances, my view is that expressed in In re Brooks et al., 24 CCPA 1203, 90 F. 2d 106, 33 USPQ 532, where, as here, this court was required to evaluate an applicant's affidavit as against the opinion of the examiner. As was said in the *Brooks* case, "* * * we are not disposed to accept the opinion of the examiner in the face of positive recitals in appellant's application, and in the face of the affidavit above referred to." See also, *In re Lowry*, 25 CCPA 829, 93 F. 2d 909, 36 USPQ 254.

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[1] It is noted that while the examiner's search discovered only a saw-tooth generator operable at 200 kilocycles as quoted in the majority opinion, the *Electrical Engineers Handbook*, 4th ed. (1950), by Pender and McIlwain indicates that a multi-vibrator type saw-tooth generator might be made to operate up to 1,000,000 cycles (1 *MC*). While this does not necessarily indicate that a person skilled in the art could readily construct a 2,000,000 cycle (2 *MC*) saw-tooth generator, it suggests caution in the use of the examiner's failure to find a reference above 200,000 cycles as to the sole basis upon which to decide what the disclosure in question teaches one skilled in the art.

The board cited *Ex parte Sziklai*, 110 USPQ 325 in support of the proposition that—

> Where a device is presented in an application essentially only by means of a labeled rectangle, with no other description or illustration of specific circuitry, it must be one of known conventional nature in the prior art in order that such presentation be regarded as a sufficient disclosure.

In the *Sziklai* case, the examiner had questioned the disclosure of "synchronous detectors" in a block diagram. In this connection, the Board of Appeals pointed out:

> It seems clear that synchronous detectors are more or less well known and appellant has filed a photostatic copy of an article from the Journal of the British Institution of Radio Engineers which indicates that the homodyne and synchrodyne methods of detection have been used for many years.

The board then held:

> It seems to us that in view of the obvious prior knowledge of synchronous detectors appellant is justified in disclosing the use of a conventional synchronous detector by means of a properly labeled rectangle.

The board in the *Sziklai* case tested the definitiveness of the disclosures by reading into them what was old and conventional in the art. Thus the board said:

> After careful consideration of appellant's disclosure, we are of the opinion that it is sufficiently definite, when taking into account the fact that the various elements enclosed within the rectangles are old in themselves and conventional in prior art television and/or

radio systems, to enable a person skilled in this art to practice the invention.[2]

Under the rationale of the *Sziklai* decision, it seems to me that the showing made by appellant constitutes a sufficient disclosure. Appellant's affidavit should have required the examiner either to accept the statements of applicant as to what is known technically to one skilled in the art, or to have categorically stated that the disclosures made by applicant were technically incorrect, and in so doing, point out the reasons why this is so. 35 U.S.C. 132.

Under these circumstances I would not attempt, as does the majority, to make a factual determination as to the technical correctness of the statements made nor would I pass on the adequacy of the disclosure for the reason stated in *In re Chilowsky*, 43 CCPA 775, 229 F. 2d 457, 108 USPQ 321, that "the Patent Office tribunals have not sufficiently explained the reasons for their rejection of the appellant's claims to permit a proper determination of that issue here."

The general situation here presented has been before this court on numerous occasions and in each instance this court has placed a duty on the Patent Office tribunals to state the reasons for the action taken. See, for example, *In re Thompson et al.*, 31 CCPA 1121, 143 F. 2d 357, 61 USPQ 498; *In re O'Keefe*, 40 CCPA 879, 202 F. 2d 767, 97 USPQ 157, and *In re Chilowsky*, supra.

[2] In passing, we observe that the examiner appears to have added his own views to the holding of the board in the *Sziklai* case, for in the letter of June 6, 1957, he said:

> The specification is further deficient in the disclosure of the structure of the generator. The use of rectangles indicates *that any apparatus of the type named in the rectangle may be inserted therein without modification.* Applicant's disclosure however requires that the sawtooth [sic] oscillator operate at two megacycles. Applicant has not indicated what oscillator circuit may be used. All sawtooth [sic] oscillators are not operable at this frequency. [Emphasis added.]

I think prosecution of this application should proceed from the point in the record where the publications and the affidavits were submitted.

For the foregoing reasons, I would reverse the decision of the board and remand the application for further proceedings.

APPENDIX B

28 U.S.C. 1256.—*Court of Customs and Patent Appeals; certiorari.*

> "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari."

In the Supreme Court of the United States

OCTOBER TERM, 1961

No. 857

CHARLES J. HIRSCH, PETITIONER

v.

DAVID L. LADD, COMMISSIONER OF PATENTS

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the Court of Customs and Patent Appeals (Pet. App. 1a-12a) is reported at 295 F. 2d 251.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on October 25, 1961 (Pet. App. 1a). A timely petition for rehearing was denied on January 12, 1962. The petition for a writ of certiorari was filed on April 10, 1962. The petitioner

attempts to invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review a judgment of the United States Court of Customs and Patent Appeals which affirmed the denial of certain patent claims by the Board of Appeals of the United States Patent Office.

2. Whether petitioner made adequate disclosure of the construction of a generator which was essential to the operation of his invention.

STATUTE INVOLVED

The Act of July 19, 1952, C. 950, Section 1, 66 Stat. 798, 35 U.S.C. 112, provides in pertinent part:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention. * * *

STATEMENT

Petitioner, in 1954, applied to the Patent Office for a patent on a certain combination of engineering tools designed to overcome a picture tube problem in color television (Pet. 1a). An essential element of the combination was a saw-tooth generator which, it was

stated, was to operate at a frequency higher than 2 megacycles (Pet. 1a-2a). The Examiner rejected the application on the ground that there had been inadequate disclosure of the method of construction of the saw-tooth generator. The basis of the rejection was that such generators, operable at 2 megacycles, were not known in the prior art and petitioner had not shown how this generator was to operate at that frequency (Pet. 2a-3a). The Examiner's decision was upheld by the Board of Appeals of the Patent Office, and petitioner then appealed to the United States Court of Customs and Patent Appeals (Pet. 1a).

The Court of Customs and Patent Appeals agreed with the Patent Office's conclusion that there had been insufficient disclosure of the saw-tooth generator. It held (Pet. 6a) that "[i]t was the examiner's duty to compel a disclosure which would enable those skilled in the art to practice the invention without having to design circuitry not shown to be readily available in the art." It further held (Pet. 5a) that such disclosure had not been made where, as here, petitioner "could not cite any reference in the literature establishing the 'conventional' construction of his 2 mc. saw-tooth signal generator, as he asserted it to be," nor describe it to the examiner.

ARGUMENT

As we have previously noted,[1] it is very doubtful whether decisions of the Court of Customs and Patent Appeals, in patent cases on appeal from the Patent Office, are now reviewable on certiorari by this Court. In any event, there would be no occasion for review in this case. The sole issue presented is the factual question whether petitioner made a sufficient disclosure in his patent application. The decision of the court below that his disclosure was inadequate was plainly correct, and there is no conflict with any prior decisions.

1. In *Postum Cereal Co.* v. *Calif. Fig Nut Co.*, 272 U.S. 693, this Court held that it lacked jurisdiction to review decisions of the Court of Appeals of the District of Columbia on appeal from determinations of the Patent Officet in patent and trademark applications. It was said that the decision in an appeal from the Patent Office was not a judicial judgment but was "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. 698-699. The jurisdiction of the Court of Appeals of the District of Columbia over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1-4, 45 Stat. 1475. But the

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[1] Brief in Opposition, *Larsen* v. *Ladd*, No. 671, this Term, pp. 5-6; and Brief in Opposition, *Commissariat a' L'Energie Atomique* v. *Watson*, No. 826, October Term, 1959, pp. 6-9, certiorari denied, 362 U.S. 977.

basic character of the proceeding was not changed, and thereafter, in denying certiorari to review decisions of the latter court in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction," citing *Postum Cereal*. In subsequent patent cases, the Court has merely denied certiorari, without more.

We believe that, despite some of the language in the *Postum Cereal* opinion, there are no constitutional obstacles to review by this Court of the patent rulings of the court below (see the Brief for the United States in *Lurk* v. *United States*, No. 481, this Term, pp. 104, *et seq.*). At the same time there is the grave doubt whether the Congress has vested this Court with that jurisdiction. In the present proceeding, the petitioner invokes 28 U.S.C. 1256 to sustain the Court's jurisdiction (Pet. 2). Section 1256 is part of the Act of June 25, 1948, 62 Stat. 683, codifying Title 28 of the United States Code. Prior to that codification, the only statutory provision authorizing this Court to review decisions of the Court of Customs and Patent Appeals was a provision relating to customs cases. That provision, Section 195 of the old Judicial Code as amended,* comprised two elements, one empowering the Court of Customs and Patent Appeals to hear appeals from the Customs Court in customs cases, and a second authorizing this Court to

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* Section 195 was amended by the Act of August 22, 1914, 38 Stat. 703, and by Section 617 of the Tariff Act of 1930, 46 Stat. 590, 762, 28 U.S.C. (1946 ed.) 308.

review such decisions. It did not refer to patent or trademark matters. The codification of Title 28 merely separated the foregoing two provisions, placing the former in 28 U.S.C. 1541 and the latter in 28 U.S.C. 1256.[3] Nothing in the codifying Act of 1948 or in its history suggests that Congress had any intention of giving this Court the power to review a class of cases over which jurisdiction had previously been withheld.

2. There is no merit to petitioner's contention that the Patent Office arbitrarily refused to accept his word that construction of a 2 m.c. saw-tooth generator was possible by one "skilled in the art" and unreasonably determined that he had made an insufficient disclosure of the generator. The burden of proof is always upon the applicant to show the patentability of his alleged invention. *Durham* v. *Seymour*, 6 App. D. C. 78, appeal dismissed, 161 U.S. 235; *Application of Aller*, 220 F. 2d 454 (C.C.P.A.). This burden was not discharged by the conclusory statement made by petitioner in an affidavit that a person skilled in the art could carry out the particular construction. Cf. *In re Swenson*, 132 F. 2d 1020 (C.C.P.A.); *International Standard Electric Corp.* v. *Marzall*, 184 F. 2d 592, 593 (C.A.D.C.).

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[3] The Reviser's Notes to Sections 1256 and 1541 confirm this derivation of those provisions.

The objects of the statutory requirement of disclosure are to require the patentee to describe his invention so that others may construct and use it after the expiration of the patent and to inform the public during the life of the patent of the monopoly asserted, so that interested people will know which features may be safely used or manufactured without a license and which may not. *Schriber Co.* v. *Cleveland Trust Co.*, 305 U.S. 47, 57. Therefore, a party claiming an invention must make a sufficient disclosure to enable any person skilled in the art to practice the invention without further research or exercise of inventive skill. *Standard Brands, Inc.* v. *National Grain Yeast Corp.*, 308 U.S. 34, 38; *Standard Oil Co.* v. *Tide Water Associated Oil Co.*, 154 F. 2d 579, 583 (C.A. 3); *Application of Beach*, 152 F. 2d 981, 983 (C.C.P.A.).

Here, however, petitioner stated (Pet. 3a) only that it was "well within the competence and knowledge of the average electronics engineer working within the fields of television and radar to design saw-tooth oscillators operable at the [2 m.c.] frequency" utilizing the constructions indicated in materials submitted by his attorney. But, as the court below noted (*ibid.*), the material referred to by petitioner disclosed "a 100 kilocycle saw-tooth wave generator, which is one-twentieth the frequency of what * * * [petitioner's] specification calls for as a minimum." And, as the court further observed (Pet. 4a), although saw-tooth generators were previously known in the art, the applicable literature disclosed that "such oscillators or generators *operable at 2 m.c.*,

in such equipment as applicant's, were not known." (Emphasis in original) In the absence of such prior knowledge it was, as the court below properly held, incumbent upon petitioner to supply the information which would establish that the generator would operate at the claimed frequency. The lack of such prior knowledge in the art and petitioner's refusal or inability to supply it, rendered petitioner's application nothing more than an invitation to experiment. That is a "fatal flaw" in the application. *Standard Brands, Inc.* v. *National Grain Yeast Corp.*, 308 U.S. 34, 38; *Standard Oil Co.* v. *Tide Water Associated Oil Co.*, 154 F. 2d 579, 583 (C.A. 3).

In re Chilowsky, 229 F. 2d 457 (C.C.P.A.), relied upon by petitioner (Pet. 21-22), is not to the contrary. Objectionable indefiniteness must be determined on the basis of the facts in each case. *Chicago Pneumatic Tool Co.* v. *Hughes Tool Co.*, 97 F. 2d 945, 948 (C.A. 10), certiorari denied, 305 U.S. 643. Moreover, the *Chilowsky* case merely held (229 F.2d at 462) that a broad allegation by the Examiner and the Board "that the application disclosure is speculative, coupled with a recitation of various difficulties which might be encountered in attempting to put it into practice, and a further assertion that there might be still other difficulties which could not be foreseen," did not constitute "a sufficiently definite statement of a basis for rejection." In the instant case, however, the court below (Pet. 5a-6a) pinpointed the defect in the application: "If [petitioner] was not in a position to take one of the four very simple circuit diagrams cited, showing lower frequency (100

k.c.) generators, and supply the component values (parameters) which would make it operate at the required frequency of 2 m.c. or higher, then he had not completed his invention."

CONCLUSION

For the reasons stated, it is respectfully submitted that the petition for a writ of certiorari should be denied.

ARCHIBALD COX,
Solicitor General.

WILLIAM H. ORRICK, JR.,
Assistant Attorney General.

ALAN S. ROSENTHAL,
JEROME I. LEVINSON,
Attorneys.

MAY 1962

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IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 857

CHARLES J. HIRSCH, *Petitioner*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent*

REPLY BRIEF FOR PETITIONER

ADOLPH C. HUGIN
821 National Press Building
Washington 4, D. C.
Attorney for Petitioner

Of Counsel:

EDWARD A. RUESTOW
59-25 Little Neck Parkway
Little Neck 62, N. Y.

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 857

CHARLES J. HIRSCH, *Petitioner*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent*

REPLY BRIEF FOR PETITIONER

Little need be said in reply to the Brief For The Respondent in Opposition.

The tortuous reasoning of Respondent with regard to this Court's jurisdiction has no basis in fact and should not deny to a petitioner the clear right of review authorized by Congress. Whatever Respondent may say of history, it is clear that Congress said the last word in 28 USC 1256 as late as 1948. This statutory section makes no division according to subject matter of cases which may be reviewed by the Supreme Court. It in no way restricts the authority to review therein set forth.

Respondent concedes that "there are no constitutional obstacles to review by this Court of the patent ruling of the court below" (p. 5, Brief) and in the following sentence implies that the question is up to Congress by saying "At the same time there is the grave doubt whether Congress has vested this Court with that jurisdiction".

The simple answer to this question is the unambiguous language of 28 U.S.C. 1256 and the cases *Caminetti* and *Yates* discussed at pages 18 through 20 of the Petition. This all adds up to the proposition that where Congress has unequivocally spoken, that is the end of it. We are forbidden to speculate when statutory language is clear and unambiguous, as are the plain words of 28 U.S.C. 1256. It is absurd for Respondent to say (Brief, p. 6) "Nothing in the codifying Act of 1948 or in its history suggests that Congress had any intention of giving this Court the power to review a class of cases over which jurisdiction had previously been withheld". The very clear words of 28 U.S.C. 1256 not only suggest such intention, they unequivocally state it. Why should we doubt that Congress meant what it said therein.

Respectfully submitted,

ADOLPH C. HUGIN
821 National Press Building
Washington 4, D. C.
Attorney for Petitioner

Of Counsel:

EDWARD A. RUESTOW
59-25 Little Neck Parkway
Little Neck 62, N. Y.